

REMARKS

In the Official Action, claims 15, 17, 20, 22 and 23 were rejected under 35 U.S.C. 112 as indefinite. The offending language has been changed to overcome this rejection. Each of these changes was made specifically to address the issue of ambiguity raised by the Official Action. In no instance was any change meant to narrow the interpretation of the claim. No amendments were made which were intended to narrow the subject matter of the claims.

In the Official Action, claims 12, 13, 15-17, 19-23 and 25 were rejected under 35 U.S.C. 102 as anticipated by Baughman, U.S. Patent No. 5,224,682. The Patent Office standard as presented in MPEP § 2131 for a *prima facie* case of anticipation requires the following:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

The Baughman reference describes a device including a split yoke drill mounting bracket 27. This mounting bracket extends from the feed shaft 42 toward the support member 12 and through a slot 20.

Each of independent claims 12, 20 and 22 describes a bracket having a retaining hole adjacent a first end to receive a fire sprinkler with that first end "extending from the

second end away from the base". This is directly opposite to the Baughman disclosure and makes possible the mounting of a fire sprinkler. The Baughman device cannot provide an extended support to accommodate the sprinkler mounting relative to a suspended ceiling. In light of the foregoing standard established by the Patent Office, there is no identity and, consequently, no anticipation.

Claims 20 and 22 additionally recite the location of the retaining hole both away from the base as presented in claim 12 but also "beyond the second arm". In contrast, the element mounted to the feed shaft 42 in Baughman is limited to between the feed shaft abutment member 38 and the feed shaft support 65. Again, the Baughman device cannot provide an extended support to accommodate the sprinkler mounting relative to a suspended ceiling. Also again, the standard established by the Patent Office for a *prima facie* case of anticipation cannot be supported by the Baughman reference.

Added claims 26 through 28 also include fasteners on one side of the base facing away from the extension of the first end. Such a feature is not found in the Baughman reference and further is impossible in view of the extension of the drill mounting bracket 27 through the support member 12. As such, none of claims 12 through 28 are anticipated by the Baughman reference. Without anticipation, *prima facie* support for a rejection under 35 U.S.C. 102 cannot be supported by the Baughman reference.

Claim 14 was rejected under 35 U.S.C. 103 over Baughman in view of Smith, U.S. Patent No. 5,829,718. MPEP § 2142 establishes the standard for a *prima facie* case of obviousness under 35 U.S.C. 103:

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

As Smith does not present the claimed features discussed above, the combination of Baughman and Smith fail to meet the third requirement for a *prima facie* case of obviousness as presented in the MPEP. Further, the diversity of devices described in both Baughman and Smith from each other and from that of the subject matter of claims 12 through 28 do not present teaching, suggestion or motivation to create a sprinkler mount through any combination of the references. As such, the first requirement for a *prima facie* case of obviousness is also unsupported by these references.

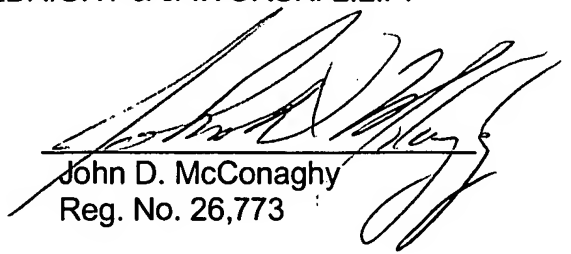
In view of the foregoing, reconsideration of the patentability of claims 12 through 25 as currently presented in the present application is requested. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

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Twenty-Ninth Floor
865 South Figueroa Street
Los Angeles, CA 90017-2576
(213) 892-9200

By:


John D. McConaghy
Reg. No. 26,773